

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the following discussion and present amendment, is respectfully requested.

Claims 24, 26-34, 36-42, and 44-49 are pending in the present application, Claims 24, 26, 31, 33, 34, 36, 41, 42, 44 and 49 having been amended, and Claims 25, 35, and 43 having been canceled without prejudice or disclaimer. Support for the present amendment is found in the previously presented claims. Applicant respectfully submits that no new matter is added, and that no new issues are raised. Accordingly, the present amendment should be entered.

In the outstanding Office Action, Claims 24-49 were rejected under 35 U.S.C. §112, first paragraph; Claims 24-26, 31, 33-36, 41-44, and 49 were rejected under 35 U.S.C. §102(b) as anticipated by Takeda; Claims 27, 29, 37, 39, 45, and 47 were rejected under 35 U.S.C. §103(a) as unpatentable over Takeda in view of de Koning et al. (U.S. Patent 6,266,512, hereinafter de Koning); Claims 28, 32, 38, and 46 were rejected under 35 U.S.C. §103(a) as unpatentable over Takeda in view of Shukunami et al. (U.S. Patent 5,031,116, hereinafter Shukunami); and Claims 30, 40, and 48 were rejected under 35 U.S.C. §103(a) as unpatentable over Takeda in view of Yoshida (U.S. Patent 5,917,612).

Applicants respectfully traverse the rejection under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement. The present specification provides support for “a storage unit configured to store user-input setting information that indicates when not to print with a substitute recording medium when a size of a recording medium indicated by a print instruction is unavailable.”

Applicants note that claim elements may be supported by the specification through *express, implicit, or inherent* disclosure.¹ If a skilled artisan would have understood the

¹ MPEP §2163(I)(B).

inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating "***the description need not be in ipsius verbis [i.e., 'in the same words'] to be sufficient***").

Thus, the exact phrase as claimed not appearing in the originally filed specification is an insufficient basis for concluding that the written description requirement is not met. Generally, there is an inverse correlation between the level of skill and knowledge in the art and the specificity of disclosure required.² The MPEP states "[t]he fundamental inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed."³ This possession may be shown in any number of ways and an Applicant need not describe every claim feature exactly because there is ***no in haec verba*** requirement. (MPEP § 2163). Rather, to satisfy the written description requirement, all that is required is "reasonable clarity." (MPEP § 2163.02).

By way of a non-limiting example, page 24, lines 11-16 of the specification describes a storage device that stores the specifying table. The specifying table is a non-limiting example of the setting information. A non-limiting example of the specifying table is shown in Applicant's Fig. 2. If the storage device stores the setting information, then it indicates that the printer prints using a substitute medium. If the storage device does not store the setting information, then it indicates that the printer does not print using a substitute recording medium. This is further described for a non-limiting embodiment at page 27, lines 7-22 of the specification, which states "or, to provide a table which records each user not wishing to use a substitute paper size."

² See, Page A-7 of the USPTO's *Written Description Training Materials*, revision 1, March 25, 2008.

³ MPEP §2163(I)(B).

Thus, the rejection under 35 U.S.C. §112, first paragraph, should be withdrawn.

Applicant respectfully traverses the rejection of Claim 25, the subject matter of which is now included in amended Claim 24. Amended Claim 24 recites, *inter alia*, “wherein after printing of a print job corresponding the print instruction has begun, the processor is configured to regard the user-input setting information as invalid and to cause a same size of the recording medium or the substitute recording medium to be used for all of a plurality of pages in the print job corresponding to the print instruction.” At least this feature is not disclosed by Takeda.

According to page 6 of the Office Action, the Office is taking the position that regarding the user-input setting information as invalid equates to checking whether or not the substitute paper size is designated. This interpretation of the claim language is too broad and incorrect. Checking to see if a substitute paper size is designated does not regard any data in table 420 of Takeda as being invalid. The process described at col. 15, lines 35-67 of Takeda does not regard any data as being invalid. On the contrary, all the data is treated as being valid and the substitute paper is used or the substitute printing apparatus is used in accordance with the data in table 420. Utilizing the data in table 420 in the process described in Takeda’ col. 15 does not involve treating any of the data in table 420 as being invalid.

Furthermore, in the invention defined by Claim 24, the regarding of the setting information as being invalid allows the processor to cause a same size of the recording medium or the substitute recording medium to be used for all of the plurality of pages in the print job. In other words, all the pages in the print job are printed on a same size medium. In Takeda, if the substitute paper size is used, then the print job is recorded on two different size papers. In Takeda, if the substitute printing apparatus is used, there is no processor causing the same size paper to be used for all the pages in the print job. There is no guarantee in Takeda that the substitute apparatus will use the same size paper as the initial apparatus.

Thus, determining a substitute printing apparatus does not necessarily mean that the processor is configured to “cause a same size of the recording medium or the substitute recording medium to be used for all of a plurality of pages in the print job corresponding to the print instruction.”

The statement in Takeda of “if the substitutive paper size is designated, the printing using the paper size is continued” includes an error. This would be understood by a person of ordinary skill in the art as “if the substitutive paper size is designated, the printing using the [substitutive] paper size is continued.” Otherwise, Takeda does not make sense. At col. 15, line 40 of Takeda, the initial paper size is depleted (i.e., empty). Thus, the printing cannot continue at the initial paper size. The system of Takeda switches to the substitute paper size, when the initial paper size is depleted, to continue printing *on the substitute paper size*.

Furthermore, the invention defined by Claim 24 includes a *processor* that *causes* all the pages to be printed on the same size medium. This is different from other extraneous circumstances leading to such a result.

Thus, Takeda does not disclose or suggest the claimed “wherein after printing of a print job corresponding the print instruction has begun, the processor is configured to regard the user-input setting information as invalid and to cause a same size of the recording medium or the substitute recording medium to be used for all of a plurality of pages in the print job corresponding to the print instruction.”

In view of the above-noted distinctions, Applicant respectfully submits that amended Claim 24 (and any claims dependent thereon) patentably distinguish over Takeda. Claims 34 and 42 recite elements analogous to those of Claim 24. Thus, Claims 34 and 42 (and any claims dependent thereon) patentably distinguish over Takeda, for at least the reasons stated for Claim 24.

Applicant respectfully traverses the rejection of Claim 26, now written in independent form. Claim 26 recites, *inter alia*, “wherein the processor is configured to cause a same size of the recording medium or the substitute recording medium to be used for all of a plurality of pages in a print job corresponding to the print instruction.” Takeda does not disclose or suggest at least this element of Claim 26.

As characterized above, the use of a substitute paper size in Takeda does not mean that all the pages in the print job are printed on a same size recording medium. The statement in Takeda of “if the substitutive paper size is designated, the printing using the paper size is continued” includes an error as noted above. The use of the substitute paper size means that a first part of the print job will be printed on a paper size designated by the print job, and that a second part of the print job will be printed on a different paper size (the substitute size). Using substitute paper size in order to continue printing in Takeda does not equate to a processor “configured to cause a same size of the recording medium or the substitute recording medium to be used for all of a plurality of pages in a print job corresponding to the print instruction.” Furthermore, the invention defined by Claim 26 includes a **processor** that **causes** all the pages to be printed on the same size medium. This is different from other extraneous circumstances leading to such a result.

Thus, Takeda does not disclose or suggest the claimed “wherein the processor is configured to cause a same size of the recording medium or the substitute recording medium to be used for all of a plurality of pages in a print job corresponding to the print instruction.”

In view of the above-noted distinctions, Applicant respectfully submits that amended Claim 26 (and any claims dependent thereon) patentably distinguish over Takeda. Claims 36 and 44 recite elements analogous to those of Claim 26. Thus, Claims 34 and 42 (and any claims dependent thereon) patentably distinguish over Takeda, for at least the reasons stated for Claim 26.

Applicant respectfully traverses the rejection of Claim 33, now written in independent form. Claim 33 recites, *inter alia*, “wherein after printing of a print job corresponding to the print instruction has begun, the processor is configured to not change a size of the recording medium indicated by the print instruction to the size of the substitute recording medium even if the user-input setting information would cause the processor to print with the substitute recording medium.” Takeda does not disclose or suggest at least this element of Claim 33.

In Takeda, the system always proceeds in accordance with the data in table 420. If the substitute recording medium is designated, then the system uses it when the initial paper size is depleted. If the substitute recording medium is null, then it uses the substitute printing apparatus when the initial paper size is depleted. Takeda does not include not changing a size of the recording medium even if the table 420 designates a substitute recording medium. There is no disclosure in Takeda of an example where the system disregards the data in table 420. Thus, Takeda does not disclose the claimed “wherein after printing of a print job corresponding to the print instruction has begun, the processor is configured to not change a size of the recording medium indicated by the print instruction to the size of the substitute recording medium *even if* the user-input setting information would cause the processor to print with the substitute recording medium.”

In view of the above-noted distinctions, Applicant respectfully submits that amended Claim 33 (and any claims dependent thereon) patentably distinguish over Takeda. Claims 41 and 49 recite elements analogous to those of Claim 33. Thus, Claims 41 and 49 (and any claims dependent thereon) patentably distinguish over Takeda, for at least the reasons stated for Claim 33.

Addressing each of the further rejections, each of the further rejections is also traversed by the present response as no teachings in any of the further cited references to de Koning, Shukunami, and Yoshida can overcome the above-noted deficiencies of Takeda.

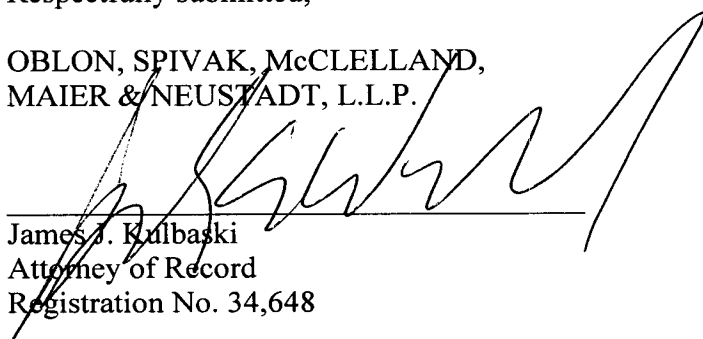
Application No. 10/768,023
Reply to Office Action of February 18, 2010

Accordingly, it is respectfully requested that those rejections be withdrawn for similar reasons as discussed above.

Consequently, in light of the above discussion and present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



James J. Kulbaski
Attorney of Record
Registration No. 34,648

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 07/09)

Joseph E. Wrkich
Registration No. 53,796